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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,519	01/04/2001	Noboru Shibuya	275738US6	4153
22850 7590 02/05/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HENNING, MATTHEW T	
			ART UNIT	PAPER NUMBER
			2131	
			NOTIFICATION DATE	DELIVERY MODE
			02/05/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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mn

Office Action Summary	Application No.	Applicant(s)	
	09/754,519	SHIBUYA ET AL.	
	Examiner	Art Unit	
	Matthew T. Henning	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1 This action is in response to the communication filed on 11/19/2007.

2 **DETAILED ACTION**

3 *Response to Arguments*

4 Applicant's arguments filed 11/19/2007 have been fully considered but they are not
5 persuasive.

6 In response to applicants' arguments against the references individually, one cannot show
7 nonobviousness by attacking references individually where the rejections are based on
8 combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*
9 *Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10 Regarding applicants' argument that Chan does not describe that the CPU 120 is powered
11 off when the computer subsystem 104 is not energized, the examiner does not find the argument
12 persuasive. Chan Col. 8 Paragraph 3 teaches that the "computer subsystem 104", which includes
13 the CPU as can be seen in Fig. 1, is not energized. To energize means to supply with an electric
14 current, and current is required for power. As such, if the subsystem does not have electric
15 current, it does not have power, and thus the power is off. As such the examiner does not find
16 the argument persuasive.

17 Regarding applicants' argument that Chan does not teach that a loading mechanism is
18 configured to read decoded data without control of the CPU 120 when the computer subsystem is
19 in an inactive state, the examiner does not find the argument persuasive. First, when the
20 subsystem is not energized, it is not possible for it to control the loading mechanism. Second,
21 Chan describes this throughout the specification, and nowhere in Chan is it described that the

Art Unit: 2131

1 when the computer subsystem 104 is not energized that the CPU does any controlling, let alone
2 controlling the audio interface. As such, the examiner does not find the argument persuasive.

3 Regarding applicants' argument that Chan does not disclose that a power controller
4 supplies power to said cross-authentication mechanism and said control mechanism even if
5 power of said CPU is turned off, the examiner does not find the argument persuasive. This
6 limitation is obvious in the combination of Tatebayashi and Chan. In the system of Tatebayashi,
7 both the cross-authentication mechanism (Elements 250 or 330) and the control mechanism
8 (Element 300) are required for operation and are both integral parts of the content reproduction
9 system. Chan teaches that unused portions of an audio reproduction system, including the CPU,
10 can be not energized to save power in the system, while energizing the necessary portions of the
11 audio reproduction system. In this combination it would have been obvious to have energized
12 both of the cross-authentication and control mechanisms while the CPU and other components
13 which are not essential to the content reproduction are not energized. This would have been
14 obvious because the ordinary person skilled in the art would have been motivated to conserve
15 energy while allowing for audio reproduction. As such, the examiner does not find the argument
16 persuasive.

17 Regarding applicants' argument that memory card reader 400 is not located in the
18 personal computer 500, the examiner does not find the argument persuasive. Tatebayashi clearly
19 teaches that the memory card reader and the memory card writer can be one in the same, as can
20 be seen in Tatebayashi Col. 51 Line 64 – Col. 52 Line 11. As such, the examiner does not find
21 the argument persuasive.

Art Unit: 2131

1 Regarding applicants' argument that it would not have been obvious to combine the
2 references in the manner suggested by the examiner, the examiner does not find the argument
3 persuasive. In response to applicant's argument that there is no suggestion to combine the
4 references, the examiner recognizes that obviousness can only be established by combining or
5 modifying the teachings of the prior art to produce the claimed invention where there is some
6 teaching, suggestion, or motivation to do so found either in the references themselves or in the
7 knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,
8 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.
9 1992). In this case, as discussed above, and below, the examiner has shown proper teachings and
10 motivation to combine such teachings. This motivation stems directly from Chen, where it is
11 taught that by utilizing the teachings of Chan, by not energizing portions of the computer,
12 including the CPU, that are not necessary during audio playback from an external source,
13 electrical power consumption can be reduced (See Chan Col. 6 Lines 37-58). As such, a proper
14 *prima facie* case of obviousness has been established, and as such, the examiner does not find the
15 argument persuasive.

16 Regarding applicants' argument that substantial reconstruction of the systems of
17 Tatebayashi and Chan be required, the examiner does not find the argument persuasive. First,
18 the applicants' have not shown what these substantial reconstructions would require, but merely
19 have asserted that substantial reconstructions would exist. Second, because of the high level of
20 skill of the ordinary person in the art, and due to the high predictability of the art, combining the
21 teachings of Chan in the system of Tatebayashi would not require neither undue experimentation,
22 nor would it destroy the focus of either of the references. Furthermore, incorporating Chan

Art Unit: 2131

1 within Tatebayashi, would mainly require incorporating elements 106 of Chan within the system
2 of Tatebayashi in the same manner that it was incorporated within the computer system of Chan,
3 with the obvious exception that the CD-ROM Drive of Chan would be replaced with the memory
4 card reader/writer of Tatebayashi within element 106 of Chan. This would be nothing out of the
5 ordinary for anyone of ordinary skill in the art. As such, the examiner does not find the
6 argument persuasive.

7 Because the arguments have not been found persuasive, the examiner has maintained the
8 rejections previously presented.

9 Claims 12, and 14-19 have been examined and Claim 1-11, and 13 have been cancelled.

10 All objections and rejections not set forth below have been withdrawn.

11 ***Claim Rejections - 35 USC § 103***

12 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
13 obviousness rejections set forth in this Office action:

14 *A patent may not be obtained though the invention is not identically disclosed or*
15 *described as set forth in section 102 of this title, if the differences between the subject*
16 *matter sought to be patented and the prior art are such that the subject matter as a*
17 *whole would have been obvious at the time the invention was made to a person having*
18 *ordinary skill in the art to which said subject matter pertains. Patentability shall not be*
19 *negated by the manner in which the invention was made.*
20

21 Claims 12, 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over
22 Tatebayashi et al. (U.S. Patent Number 6,859,535) hereinafter referred to as Tate, and further in
23 view of Chan et al. (US Patent Number 6,226,237) hereinafter referred to as Chan.

24 Regarding claim 12, Tate disclosed a general-purpose computer having a central
25 processing unit which can decode data stored in an internal storage mechanism as instructed by a

Art Unit: 2131

1 program stored in said internal storage mechanism (See Tate Col. 8 Lines 31-51), comprising: a
2 loading mechanism, which is integrally arranged on a case of said general-purpose computer, for
3 detachably accommodating an external storage card (See Tate Fig. 2 Elements 501 and 300); a
4 decoding mechanism configured to decode data read from said external storage card (See Tate
5 Col. 8 Lines 31-51 and Fig. 6 Element 460); a reproduction mechanism configured to reproduce
6 decoded data decoded by said decoding mechanism (See Col. 8 Lines 31-51); and said loading
7 mechanism is configured to read said decoded data based on commands from said central
8 processing unit when said general-purpose computer is in an active state (See Tate Col. 52
9 Paragraph 1), and a cross-authentication mechanism configured to cross-authenticate said
10 external storage card through said loading mechanism (See Tate Col. 11 Lines 3-20); and a
11 control mechanism for supplying copyrighted data read from said external storage card to said
12 reproducing mechanism upon successful cross-authentication by said cross-authentication
13 mechanism (See Col. 8 Lines 44-51), but failed to disclose a power controller that supplies
14 power to said general-purpose computer, wherein said power controller supplies power to said
15 decoding mechanism and said reproduction mechanism even if power of said central processing
16 unit is turned off, and said loading mechanism is configured to read said decoded data without
17 control of a central processing unit when said general-purpose computer is in an inactive state, or
18 wherein said power controller supplies power to said cross-authentication mechanism and said
19 control mechanism even if power of said central processing unit is turned off.

20 Chan teaches that when computers reproduce audio from an external device, much of the
21 power consumed by the computer is in peripherals not actually being used (See Chan Col. 1),
22 and further teaches that in such situations, unused portions of the computer, including the CPU,

Art Unit: 2131

1 can be powered off (un-energized), and when the CPU is energized the CPU will control the
2 audio playback commands, but when the CPU is not energized, an audio sub-system should
3 remain energized to control the playback of the audio without use of the CPU (See Chan Col. 8
4 Paragraphs 2-3), and further teaches that the audio sub-system should have a track number
5 display and an Icon LCD which the audio subsystem uses to indicate operation (See Chan Col. 6
6 Lines 52-58).

7 It would have been obvious to the ordinary person skilled in the art at the time of
8 invention to employ the teachings of Chan to the music playing system of Tate in order to shut
9 off the power to the idle personal computer while reading the data from the external medium by
10 the content player subsystem, and having a display configured to display operating
11 characteristics of the audio device when the computer is idle. This would have been obvious
12 because the ordinary person skilled in the art would have been motivated to reduce the power
13 consumed by the system.

14 In this combination it would have been obvious to the ordinary person skilled in the art to
15 have energized the card reader/writer and its components, including the mutual authentication
16 unit, while the CPU of the personal computer and other components which are not essential to
17 the content reproduction are not energized. This would have been obvious because the ordinary
18 person skilled in the art would have been motivated to conserve energy while allowing for audio
19 reproduction.

20 Regarding claim 14, Tate and Chan disclosed that when said external storage card has
21 been cross-authenticated with said general-purpose computer, an external storage card control

Art Unit: 2131

1 mechanism plays copyrighted music data on a portable music playing device by connecting said
2 external storage card to said portable music playing device (See Tate Col. 8 lines 44-51).

3 Regarding claim 15, Tate and Chan disclosed that in an inactive state in which no electric
4 power is supplied to said general-purpose computer, an external storage card control mechanism
5 reads copyrighted data from said external storage card and supplies said copyrighted data to a
6 portable music playing device (See Tate Col. 8 Lines 44-51 and the rejection of claim 12 above).

7 Regarding claim 16, see the rejection of claim 12 above.

8 Regarding claim 17, Tate and Chan disclosed that a function equivalent to a portable
9 music playing device is realized by executing, by a controller of said general-purpose computer,
10 a program stored in said internal storage mechanism of said general-purpose computer (See Tate
11 Col. 1 Lines 29-37 and Col. 8 Lines 31-51 and col. 52 Paragraph 1).

12 Regarding claim 18, Tate and Chan disclosed that said internal storage mechanism is a
13 hard drive (See Tate Lines 31-34).

14 Regarding claim 19, Tate and Chan disclosed that said copyrighted data is encrypted
15 copyrighted data (See Tate Abstract).

16 *Conclusion*

17 Claims 12, 14-19 have been rejected.

18 Applicant's amendment necessitated the new ground(s) of rejection presented in this
19 Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
20 Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21 A shortened statutory period for reply to this final action is set to expire THREE
22 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 2131

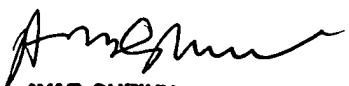
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew Henning/
Assistant Examiner
Art Unit 2131
8/14/2007


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